

**REMARKS**

The Office Action mailed September 22, 2004 has been carefully reviewed along with the references cited therein. In the Office Action, the Examiner rejected claim 1 as being anticipated by Chasan (U.S. Patent No. 5,988,174). In this Office Action, Applicant has amended claim 1 and added new claims 2-10.

Chasan is directed to a surgical marking pen to having a pin wheel 14 attached at one end. The pin wheel includes a plurality of marking points 18 that penetrate a portion of the epidermis of a patient. The marking pen 2 includes a reservoir mechanism 24 having a groove 28 formed therein (FIGURE 2). The groove 28 is disposed so that the marking points 18 of the pin wheel 14 pass through the groove and next to the felt that defines the side of the groove. A small amount of marking agent is transferred to an end of the marking point and the marking agent is held in place by surface tension of the marking agent. As each marking point contacts the patient's skin, a small puncture is formed and the marking agent is deposited in the small puncture. (Col. 3; lines 33-35).

Claim 1 has been amended recite that the wheel comprises a polymer that absorbs ink. Support for this limitation can be found in the specification on page 4 in the first full paragraph. The Chasan marking pen discloses a pin wheel that does not absorb ink. Instead, the marking agent is held to the pin wheel by surface tension of the marking agent. Accordingly, Chasan fails to anticipate amended claim 1.

Furthermore, it would not have been obvious to modify the marking pen disclosed in Chasan such that it would read upon amended claim 1. The marking pen in Chasan is rolled across a person's skin to penetrate a portion of the epidermis. (Col. 3, lines 33-35). Modifying the marking pen of Chasan such that the wheel comprises a polymer that absorbs ink would destroy the intended function of the marking pen disclosed in Chasan because by making the pin wheel from such a polymer would most likely prohibit the pin wheel from penetrating a portion of the patient's epidermis. Accordingly, claim 1 as amended patentably defines over the Chasan reference.

Claim 2 recites that the wheel comprises a flat or arcuate marking surface. In contrast, the marking pen disclosed in the Chasan reference includes the pin wheel 14 having marking points 18 disposed so that they have sufficient taper to a point 34 so that penetration of the skin is possible. (Col. 4, lines 58-65). Accordingly, the Chasan reference fails to disclose the limitation recited in claim 2. Furthermore, it would not have been obvious to modify the marking pen disclosed in the Chasan reference such

that it would read upon claim 2. By making the marking points 18 to include a flat or arcuate marking surface would inhibit the marking points from penetrating the epidermis of a patient. This would destroy the intended function of the marking pen disclosed in the Chasan reference. Accordingly, claim 2 further patentably defines over the Chasan reference. Claims 3-6 recite further limitations that are not disclosed by the Chasan reference. Accordingly, these claims further define over the Chasan reference.

Claim 7 recites that the wheel includes a flat or arcuate marking surface disposed along a peripheral edge, wherein the marking surface is adapted to mark on a patient's skin. As discussed with reference to claim 2, above, the Chasan reference discloses a marking pen that includes marking points that penetrate the epidermis of the patient. Accordingly, Chasan fails to anticipate claim 7. Furthermore, it would not have been obvious to modify Chasan such that it reads on claim 7 because such a modification would destroy the intended function of the marking pen disclosed in Chasan.

Claims 8-10 recite further limitations that define over the Chasan reference.

All formal and informal matters having been considered, it is respectfully submitted that claims 1-10 patentably define over the references cited by the Examiner.

Accordingly, Applicant submits that the application is now in condition for allowance. An early indication of such is earnestly solicited.

Respectfully submitted,

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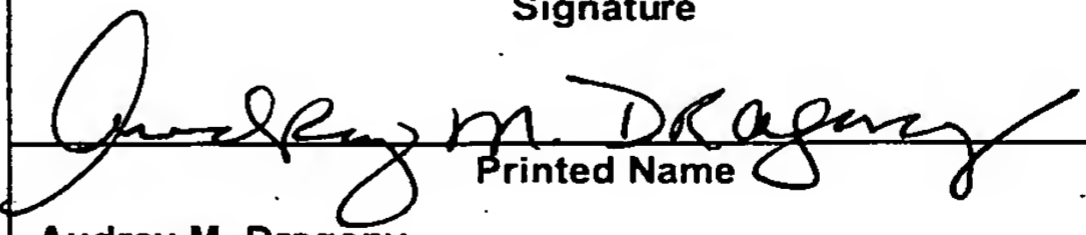
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